



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,719	09/07/2004	Norio Sugawara	450100-04894	5177

7590 10/08/2008
William S Frommer
Frommer Lawrence & Haug
745 Fifth Avenue
New York, NY 10151

EXAMINER

BUI, HUNG S

ART UNIT	PAPER NUMBER
----------	--------------

2841

MAIL DATE	DELIVERY MODE
-----------	---------------

10/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/506,719	Applicant(s) SUGAWARA ET AL.	
	Examiner HUNG S. BUI	Art Unit 2841	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 11-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/07/04; 2/15/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in 2003-002675 on 01/08/2003 and 2003-156072 on 05/30/2003.

Election/Restrictions

2. Claims 11-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 06/09/2008.

3. Applicant's election with traverse of the invention of species restriction in the reply filed on 06/09/2008 is acknowledged. The traversal is on the ground(s) that "a search for the invention defined by the claims of one group will require a search that encompasses the claims of the other groups and, thus, the claims covering both species will be searched." This is not found persuasive because, it appears that the claims are generic, the features recited in each of the species are mutually exclusive and would require divergent searches, completely different searching for each. All of these factors taken into consideration would present a burden on the examiner to search and examine all of the species.

However, if the generic claims are found to be allowable at some point during prosecution, full consideration will be given to withdrawing the restriction requirement and rejoining all of the species.

Oath/Declaration

4. The oath/declaration filed on 09/07/2004 is acceptable.

Information Disclosure Statement

5. The IDS filed on 09/07/2004 and 02/15/2008 have been considered and made of record.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1-10 are rejected under 35 U.S.C. 102(a) as being anticipated by Sugawara [EP 1467310].

Regarding claim 1, Sugawara discloses an external storage apparatus (10, figures 4-13) characterized by comprising:

- a main body (11, figure 4);
- a memory substrate (23, figure 5), on which at least a semiconductor memory (21, figure 5, paragraph 0025, lines 4-5) mounted, having an external connection terminal (24, figure 5) at one end thereof;
- a substrate holder (13, figure 5, paragraph 0022, line 5) having a substrate insertion through-hole (see figure 5) therein through which the memory substrate to be

Art Unit: 2841

inserted, for fixing the memory substrate to the main body under in such a way that the external connection terminal projects outward from an opening at one end of the substrate insertion through-hole; and

- a cap (14, figure 4, paragraph 0022, line 5) to be attachable and detachable to and from the substrate holder for protecting the external connection terminal;

wherein erroneous assembly restricting means (12b, 38 and 39, figures 8-9) is provided in the main body, for restricting assembly if assembly posture of the memory substrate is not correct.

Regarding claim 2, Sugawara discloses the erroneous assembly restricting means is a rib (12b, figure 8) extending to a direction intersecting with other end of the memory substrate and restricts advancement of the memory substrate into the main body by contacting with other end of the memory substrate if assembly posture of the memory substrate with respect to the main body is not correct.

Regarding claim 3, Sugawara discloses a holding groove (12b, figures 8-9, paragraph 0043) is formed on the rib, for holding other end of the memory substrate if assembly posture of the memory substrate with respect to the main body is corrected.

Regarding claim 4, Sugawara discloses the holding groove holds the memory substrate in accompaniment with plastic deformation (paragraph 0067) as the memory substrate advances.

Regarding claim 5, Sugawara discloses a guide groove (figure 9) is formed on the rib, for guiding advancement of the memory substrate into the main body if assembly posture of the memory substrate with respect to the main body is correct.

Art Unit: 2841

Regarding claim 6, Sugawara discloses a holding section (see figures 8-9) is provided at a bottom of the main body, for holding other end of the memory substrate advanced.

Regarding claim 7, Sugawara discloses the holding section holds the memory substrate in accompaniment with plastic deformation due to advancement of the memory substrate (paragraph 0067).

Regarding claim 8, Sugawara discloses the main body has a space thorough which the substrate holder is inserted, and a restriction section is provided on an inner surface of the space, for restricting advancement of the substrate holder into the space by contacting with the substrate holder (see figure 8) if assembly posture of the substrate holder with respect to the main body is not correct.

Regarding claim 9, Sugawara discloses a plurality of liner ribs (28, figure 4, paragraph 0049) is provided on an outer surface of an end region at inserted side of the substrate holder to the space, along an insertion direction of the substrate holder with respect to the space; and wherein the plurality of liner ribs is respectively provided positions where the ribs does not contact with the restriction section if assembly posture of the substrate holder with respect to the main body is correct and where the ribs contact with the restriction section if assembly posture of the substrate holder is not correct.

Regarding claim 10, Sugawara discloses at least some of the plurality of ribs are functioned as a welding rib (paragraph 0049) between the main body and the substrate holder during ultrasonic welding.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Liang et al. [US 7,066,742] disclose information means with waterproof and transmitting light characteristic;
- Chen [US 2004/0233645] discloses portable data storage device; and
- Su [US 2003/0099090] discloses portable external hard drive.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG S. BUI whose telephone number is (571)272-2102. The examiner can normally be reached on Monday-Friday 8:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A. Reichard can be reached on (571) 272-2800 ext. 31. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2841

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hung S. Bui/
Primary Examiner, Art Unit 2841.